

REMARKS

First of all, one of the inventors, Dr. Daniel Anderson, as well as Dr. Sam Pasternack and the undersigned agent, wish to thank Examiner Baker for according them a telephone interview on August 14, 2003.

After Dr. Anderson explained the context in which the present invention resides, the rejection of claims 1-5, 8-12 and 14-20 as anticipated by Khrapko et al. (US 5,552,270) under 35 U.S.C. §102(b) was discussed. Applicant noted that Khrapko et al. teaches a device that includes a plurality of “gel portions” or “gel cells” that are all made of the *same* polymeric material, namely polyacrylamide (e.g., see column 3, lines 1-3 and column 3, line 57 to column 4, line 15). This was contrasted with the microarray of the present invention that includes a plurality of *different* polymeric biomaterial elements. The present amendments of claims 1-2 were proposed to more clearly distinguish the claimed invention from the teachings of Khrapko et al. The Examiner indicated that these amendments would be given favorable consideration.

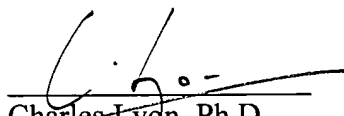
The rejection of claim 12 under 35 U.S.C. §112, second paragraph was then discussed. Applicant again noted that the terms “drugs”, “growth factor” and “combinatorial compound” are well known terms of art and that a skilled person would know what is and what is not a “drug”, “growth factor” or “combinatorial compound”. The Examiner maintained her rejection and suggested that Applicant consider replacing the terms with language that points out the function of the added compounds. The Examiner indicated that such functional language although possibly broader would be more specific and hence likely to meet the requirements of 35 U.S.C. §112, second paragraph. In order to further prosecution of this case towards allowance, Applicant has therefore added new claim 55 that includes the language “further comprises a compound that affects an aspect of cellular behavior selected from the group consisting of adhesion, proliferation, differentiation and gene expression” (e.g., see support on page 1, lines 10-11 and page 13, lines 6-9). Applicant has also amended claim 12 and added new claims 56-58. The language “drugs”, “growth factors” and “combinatorial compounds” has been canceled from claim 12. The term “growth factors” has been presented in claim 56 as depending from the “proteins” of claim 12 (e.g., see page 12, lines 23-27 for support). The term “drugs” has been replaced with the terms “small molecule drugs” in claim 57. Applicant respectfully submits that a skilled person would understand that the description of “drugs” that is provided in the specification (e.g., see page 13, lines 3-17) supports such terms and that a “small molecule drug” is a term of art that is understood to encompass all natural and synthetic small molecules

that are commonly administered as pharmaceuticals. The term "combinatorial compounds" has been replaced with "a compound that belongs to a synthetic combinatorial library of compounds" in claim 58 (e.g., see claim 53 and page 13, lines 6-9 for support). Applicant respectfully requests that the indefiniteness rejection of claim 12 be withdrawn in light of this amendment.

Finally, the rejection of claims 1-6, 8-12 and 14-20 under 35 U.S.C. §112, first paragraph for lack of written description was discussed. The Examiner indicated that in this regard her greatest concern was with the terms "polymeric biomaterial". The Examiner further indicated that the claim amendments that had been proposed to overcome the 102(b) rejection would go some way towards alleviating her concern. After a brief discussion of the methods that Applicant has used to prepare various microarrays, Applicant suggested further amending claims 1 and 2 to specify that the polymeric biomaterials include a *soluble* synthetic polymer. The Examiner agreed that such an amendment was well supported by the specification (e.g., see page 2, lines 28-22; page 8, line 28 to page 9, line 1; page 12, lines 1-7; and page 14, line 23 to page 15, line 8) and that it would further move prosecution of this case in the right direction.

Based on the arguments presented above, it is submitted that the pending claims, as amended herein, are allowable over the art of record. Applicant would again like to thank the Examiner for granting a telephone interview and for her thoughtful comments and careful consideration of the case. If a further telephone conversation would help expedite prosecution of this case, please do not hesitate to contact the undersigned at (617) 248-4793. Additionally, please charge any fees that may be required, or credit any overpayment, to our Deposit Account No. 03-1721.

Respectfully submitted,


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Limited Recognition Under 37 CFR §10.9(b)

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